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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/656,581	09/06/2000	Robert Filepp	IBM, FILEPP ET AL. 012 PCS	9843

7590

11/23/2001

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EXAMINER

DINH, DUNG C

ART UNIT

PAPER NUMBER

2153

DATE MAILED: 11/23/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/656,581

Applicant(s)

FILEPP ET AL.

Examiner

Dung Dinh

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

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DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-51 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As per claim 1, the specification supports the recited limitations except for the highlighted portions:

a user reception system [fig.2 station 400's] having a reception system program coupled to the network, the user reception system providing requests for information on the network;

a content host [fig.2 file server 205] responsive to request for information to provide application content, information regarding advertising screen partitions for display of advertising content and a location designation to the user reception system;

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an advertiser host [fig.2 business system 130] including advertising content [col.9 lines 18-23], the advertiser host responsive to a request to provide the advertising content; and

(Rec. feature 119)
an advertisement host responsive to a request from the user reception system based on the location designation to select an advertiser host as a selected advertiser host, and identify the advertiser host as the selected advertiser host to the user reception system,

whereby the advertising content from the selected advertiser host is displayed at the user reception system.

The specification does not disclose four separate entity as claimed: a user reception system, a content host, an advertiser host, and an advertisement host. It is unclear which elements in the specification correspond to the claimed advertiser host and the advertisement host. The examiner failed to find in the specification support for the limitation "a location designation". Further more the specification does not have support for the function performed by the advertisement host as recited in the claim: responsive to request from user reception system based on the location designation to select an advertiser host.

As per claims 2-4, the specification lacks support for the limitation: "the advertisement host selects the advertiser host ...". The examiner failed to find teaching in the specification

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of a host selecting another host, based on some form of criteria, to serve advertising content to the user reception system.

As per claims 5 and 6, the specification lacks support for "the location designation ". It is unclear what element or function in the specification correspond to this claimed element.

Claims 7-12, 13-18, are rejected under same rationale as for claims 1-6 above.

Claims 19-22, 23-28, the specification lacks support for the limitation: "the location designation" provided by the content host and an advertisement host responsive to request from user reception system based on the location designation to select an advertising content.

Claim 20, the specification lacks support for the limitation: "the advertisement host selects the advertiser host ..."

Claims 29-31, the specification lacks support for the limitation: a content host ... providing a location designation to the user reception system identifying the network address of the advertisement host ... for providing advertising content.

Claims 32-37, the specification lacks support for the claimed advertiser host and the advertisement host limitations.

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Claims 38-40, the specification lacks support for the claimed "location designation" and the steps:

*sending a request from the user ... based on the location designation ...
selecting, at the advertisement host advertising content;
sending a reply from the advertisement host identifying advertising
content to the user reception system;*

Claims 41-46, the specification lacks support for the claimed "location designation" and the steps:

*sending a request from the user ... based on the location designation ...
to select an advertiser host;
selecting, at the advertisement host, an advertiser host;
sending a reply from the advertisement host to the user reception
system identifying the selected advertiser host;
sending a request from the user reception system to the advertiser host
to provide the advertising content to the user;
sending a reply from the advertiser host the the user reception system
containing the advertising content;*

Claims 47-50, the specification lacks support for similar limitations as stated for claim 41-46 above.

Claim 51, the specification lacks support for the "location designation" limitation:

*an advertisement host responsive to a request from the user reception
system based on the location designation to select advertising content for
the advertising space, and to reply to the request from the user computer by
identifying the advertising content to the user computer,*

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whereby the advertising content identified by the advertisement host is acquired by the user computer and displayed in the advertising space.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dung Dinh whose telephone number is (703) 305-9655. The examiner can normally be reached on Monday-Thursday from 7:00 AM - 4:30 PM. The examiner can also be reached on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached at (703) 305-4792.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group 2100 Customer Service whose telephone number is (703) 306-5631.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

or faxed to:

(703) 746-7238, (for formal communications intended for entry)
(703) 746-7240 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Fourth Floor (Receptionist).



Dung Dinh
Primary Examiner
November 8, 2001